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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/176,866 | 10/22/1998 | JAMES V. YOUNG | 6996 | 2374 |

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EXAMINER

DEMILLE, DANTON D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3764

DATE MAILED: 11/29/2004

33

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/176,866

Applicant(s)

YOUNG, JAMES V.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 15-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **The specification is objected to as failing to provide an adequate written description of the invention.** There is no support in the specification for the invention as now claimed.

There is no support for the applicator and connection tube to being substantially free of any structure that would block the entry of the contaminants into the connection tube. In fact the opposite would appear to be true for the applicator as disclosed. In figure 8 for example, as the contaminants would be sucked into the applicator through holes 56', 56'' they would impact the back wall because the connection tube is spaced a distance away from the entrance of the applicator head. As shown by the arrows in the drawing the path of the contaminants would take a very abrupt right turn just after entering the applicator head. The inertia of most contaminants would impact the back wall of the applicator head thereby preventing most contaminants from ever reaching the connection tube. Moreover, the size and location of the connection tube being small and located distant from the location where the contaminants would first enter the head would preclude contaminants from reaching the connection tube. The same would be true for the embodiment of figure 5 since the connection tube is at right angles to the direction of flow of contaminants entering the applicator head. The location of the connection tube in the side wall of the applicator head would also impede smooth continuous flow of contaminants.

3. **Claims 1-7, 9 and 15-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new claim language is not supported by the specification as originally disclosed as noted above.

4. **The amendment filed 7/23/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.** 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the applicator and connection tube being substantially free of any structure that would block the entry of the contaminants into the connection tube.

5. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

6. **Claims 1 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Holt.**

7. Applicant's structure includes a back wall to which the contaminants would impact as they are being sucked into the applicator. The contaminants of Holt would follow a very similar path as applicant's. The contaminants would have to take the same abrupt right turn just after entering the applicator just as applicant's. Holt's structure would not appear to be significantly any different from applicant's arrangement. Therefore it is maintained that Holt anticipates the

invention as claimed, as confirmed by the Board of Appeals and as set forth in the Examiner's Answer and previous final rejection.

8. Claims 2 and 3 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Holt as confirmed by the Board of Appeals and as set forth in the Examiner's Answer and previous final rejection.

9. Claims 4 and 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Holt in view of Howerin as confirmed by the Board of Appeals and as set forth in the Examiner's Answer and previous final rejection.

10. Claims 6, 7, 9 and 15-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Holt in view of Marshall et al. and Rohrer as confirmed by the Board of Appeals and as set forth in the Examiner's Answer and previous final rejection.

11. Claims 19 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 18 above, and further in view of Howerin as confirmed by the Board of Appeals and as set forth in the Examiner's Answer and previous final rejection.

12. To any extent the claims somehow define over Holt's device the following appears appropriate.

13. Claims 1, 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell in view of Holt.

14. Birrell teaches an applicator that includes a massage head 38 driven by a motor through a cable 21. The applicator and connection tube of Birrell would appear to be even more substantially free of any structure that would block the entry of contaminants into the connection

tube than applicant's. The connection tube of Birrell is located at less of an angle from the apertures in the head of the applicator. The contaminants would be more free of obstruction as they enter the connection tube from the head than applicant's invention by the virtue of the more direct line into the connection tube.

15. The only difference between Birrell and the claimed invention may be the type of motor used. Birrell uses a hydropowered motor to provide the rotation of the cable. Holt teaches an electronic motor. It would have been obvious to one of ordinary skill in the art to modify Birrell to use an electric motor as taught by Holt to free one's dependence on having to use a pressurized water source.

16. Regarding claim 3, it would have been obvious to one of ordinary skill in the art to further modify Birrell to provide a collection vile for the vacuum in order to catch any uncollected particulate matter from contaminating the motor.

17. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell in view of Holt as applied to claim 1 above, and further in view of Howerin.

18. It would have been obvious to one of ordinary skill in the art to further modify Birrell to provide a second vile in the vacuum line to collect any liquids as taught by Howerin to catch any liquid to prevent damage or impairing the function of the motor.

19. Claims 2, 6, 7, 9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell in view of Holt as applied to claim 1 above, and further in view of Marshall et al. and Rohrer.


20. It would have been obvious to one of ordinary skill in the art to further modify Birrell to use a motor control system as taught by Marshall to best control the operation of the device and

to shape the applicator to be concave as taught by Rohrer to better conform to the shape of the human body.

21. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell in view of Holt as applied to claim 18 above, and further in view of Howerin.

22. It would have been obvious to one of ordinary skill in the art to further modify Birrell to provide a second vial in the vacuum line taught by Howerin to catch any liquid to prevent damage or impairing its efficiency.

ddd
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